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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,480	03/15/2004	Paul Liao	9432-000210/COB	3191

27572 HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 828 BLOOMFIELD HILLS, MI 48303	7590 10/19/2007
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EXAMINER	
DURAN, ARTHUR D	

ART UNIT	PAPER NUMBER
3622	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/800,480	Applicant(s) LIAO ET AL.	
	Examiner Arthur Duran	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 14-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected. ^{1-13 and 24-29}
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 14-23 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-29 have been examined.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claim 1-13 and 24-29, drawn to adaptive electronic coupons, classified in class 705, subclass 14.
 - II. Claim 14-23, drawn to a communication system and device related to television watching, classified in class 705, subclass 14.

Inventions I, and II are based on different sets of Independent claims. Group I involves adaptive electronic coupons. Group II involves a communication system and device related to television watching.

Because these inventions are distinct for the reasons given above and the search required for Group I is different than the search required for each of Group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Gregory A. Stobbs (28,764) at 248-641-1600 on December 15, 2005 a provisional election was made without traverse to prosecute the invention of Group I, 1-13 and 24-29. Affirmation of this election must be made by applicant in replying to this Office action. Claims 14-23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 27-29 are rejected under 35 USC 101. The electronic coupon of independent claim 27 is non-functional data per se. It does not matter if the coupon is on a memory. The coupon claimed still acts as data per se. See MPEP 2106 (IV)(B)(1)(b).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 24 recites the limitation "variable expiration terms". There is insufficient antecedent basis for this limitation in the claim. The claim is written as if the "variable expiration terms" have already been stated in the claims. However, the term "variable expiration terms" is has not proper antecedent basis.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1-13 and 24-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mittal (2003/0154125).

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Claim 1, 7, 27: Mittal discloses a system for conditionally redeeming an electronic coupon, comprising:

a distribution module distributing an adaptive electronic coupon to a user;

electronic coupon metadata automatically changing redemption characteristics of the coupon post distribution based on predetermined conditions relating to personal data of the user and a redemption environment;

a redemption system honoring the adaptive electronic coupon at a time and place of redemption based on the predetermined conditions relating to the personal data of the user and the redemption environment (Fig. 12; [70-76]; [59]; [60]; [61]; [48]; [101-110]; Abstract).

Mittal further discloses an active display adapted to visually render an electronic coupon according to the electronic coupon data and variable expiration terms associated therewith ([48]; [49]; [53]; Fig. 13).

Mittal does not explicitly disclose utilizing a handheld computer device.

Mittal discloses a mobile user utilizing a handheld device ([112]) and a variety of computer related devices ([115], [126]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Mittal's mobile user utilizing a handheld device and who utilizes a computer can utilize a handheld computer device. One would have been motivated to do this in order to allow the user utilization of convenient computer device options.

Mittal further discloses utilizing predetermined ranges and predetermined rules (Claims 10-14) and predetermined classes (Claim 26) related to coupons.

Claim 2, 10: Mittal discloses the system of claim 1, comprising a verification system verifying that the predetermined conditions have been met at the time and place of redemption (Fig. 12).

Claim 3: Mittal discloses The system of claim 1, wherein the redemption characteristics correspond to a redemption category and a redemption value (Fig. 12; Claims 10-14; [53]; and above claim 1 rejection).

Claim 4, 11: Mittal discloses the system of claim 1, wherein the predetermined conditions relate to a time of redemption (see above claim 1 rejection).

Claim 5, 12, 26, 28: Mittal discloses the system of claim 1, wherein the predetermined conditions relate to a place of redemption (see above claim 1 rejection).

Claim 6, 13: Mittal discloses the system of claim 1, wherein the predetermined conditions relate to a weather condition at a time and place of redemption ([48]).

Claim 8: Mittal discloses the method of claim 7, wherein said distributing the adaptive electronic coupon to the user corresponds to distributing the adaptive electronic coupon to the user, wherein the adaptive electronic coupon has a redemption category, a redemption value, and adaptability metadata defining dependency of at least one of the redemption category and the redemption category on the predetermined conditions (Fig. 12; Claims 10-14; [53]; and above claim 7 rejection).

Claim 9: Mittal discloses the method of claim 8, wherein said automatically changing redemption characteristics of the coupon based on predetermined conditions relating to personal data of the user and a redemption environment corresponds to changing at least one of the redemption category and the redemption value according to

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the predetermined conditions (Fig. 12; Claims 10-14; [53]; and above claim 7 rejection).

Claim 25, 29: Mittal discloses the portable viewer of claim 24 wherein said metadata includes at least one datum for mediating redemption expiration terms ([48]; [49]; [53]).

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a) Roberts (6,493,110) discloses utilizing a variety of hand-held devices (col 5, lines 45-55).

Roberts disclose that the characteristics of the electronic coupon can be dynamically adjusted based upon user characteristics, including redemption amounts (col 9, lines 25-37; col 16, lines 36-46;).

Roberts further discloses a variety of variable coupon data including location and expiration date information (col 15, lines 52-59).

Roberts further discloses varying coupon information depending upon personal information of the user (col 17, line 60- col 18, line 5).

Roberts further discloses varying coupons based upon a variety of store, user, and utilization information (col 16, line 60-col 17, line 30).

Roberts further discloses adjusting date information (col 16, lines 20-25) and performing actions on coupons based upon coupon expiration date information prior to a time of attempted redemption (col 16, lines 5-39).

b) Denimarck (20030018522) discloses variable coupons related to weather:

“[0057] A method of identifying a customer at one of the customer identification stations 56 will now be described. A customer 58 enters the retail establishment 20 and approaches a customer station 56 (FIGS. 1-3). The customer 58 is identified by entering a pin code into the pin code entry device 68 and providing a biometric characteristic, e.g., thumbprint, to the biometric sensing device 72. A customer record is obtained based on one or more queries including the submitted pin code and biometric characteristic profile. The terminal 60 may prompt the customer via the display 72 of one or more customer options once the customer is identified. One option may be to print one or more shopping coupons (e.g., manufacturers coupon, retail establishment coupon) for the customer's use. The type of shopping coupons and amount may be based on, for example, one or more of the following: the shopping history of the customer, the time of day, the day of the week, the season, the weather, regional preferences, goods in excess supply, goods with an approaching expiration date, etc. Upon selection of this option, one or more relevant coupons may be printed by the printer 64.”

c) Hassell (20010042010) discloses variable coupons:

“[0058] Additionally, since the system never loses track of any given coupon during its life, coupon information may be changed by the system during its life span and detailed information about the user may be obtained, for example, purchasing habits, likes and dislikes, clipping to usage ratios, etc. Moreover, from the advertiser perspective, important market research information may be

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obtained. For example, a given advertiser may offer coupons for the same items in differing amounts to determine the discount amount which produces the greatest amount of traffic or sales. Similarly, this information allows an advertiser to offer consumers specifically targeted discounts which are more likely to result in increased sales. In other embodiments, advertisers can implement a micro pricing model whereby the value of a coupon can vary based upon factors such as the hosting website, time of day, duration to expiration, the coupon's transfer history, the popularity, an optimal pricing analysis or the redemption site.”

d) Deaton discloses variable coupons and electronic coupons:

“Point-of-sale incentives may be spooled or stored electronically. If incentives NOT previously stored electronically, GOTO 180. 165 Electronic coupons were previously stored and will now be redeemed. Choose media for previous storage of electronic coupons. 166 If coupons stored on a "SMART" Card: 167 AP/M accesses first coupon from "SMART" card using "SMART" card read/write device. 168 If no more coupons, GOTO 180. 169 AP/M sends coupon to CVC controller. 170 CVC controller checks coupon against items purchased. If item was purchased: 171 Coupon information is sent to ECR Controller. 172 ECR Controller credits customer's purchase amount for value of coupon. 173 CVC Controller updates coupon database to reflect redemption. 174 AP/M access next coupon from "SMART" card. GOTO 168. 175 If coupons stored on mass storage device in CVC controller: 176 CVC Controller accesses first coupon from storage. 177 If no

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more coupons, GOTO 180. 178 CVC Controller checks coupon against items purchased. If item was purchased: EXECUTE steps 171-173, THEN PROCEED WITH 179. 179 Read next coupon from CVC Controller's mass storage. GOTO 177.

(537) FIG. 34 is a flow chart of the disbursement of point-of-sale incentives either by the printing out of a coupon or by storage of electronic funds on a smart card or by a mass storage device at the controller 965”

e) Barnett (6,321,208) disclose variable coupons:

Barnett discloses that the coupons are fully digital promotions as they can be electronically sent and/or electronically redeemed (col 11, lines 33-45). And, furthermore, each field of the coupon is known and tracked as coupons can be deleted based upon the expiration date field of the coupon (col 11, line 64-col 12, line 6). Also, specific coupon data or coupon fields are known and can be electronically changed (col 12, lines 5-10; col 13, lines 24-35). Barnett further disclose that specific fields of coupons are known, tracked, and variable (col 12, lines 19-25; col 13, lines 24-35; col 12, lines 44-50). Barnett further discloses tracking historic buying profiles of users (col 8, lines 17-20). Furthermore, note the extensive information available relevant to purchasing and/or coupons (Fig. 2; Fig. 3; Fig. 5; Fig. 10; and citations from rejection above).

Hence, the coupon of Barnett is a fully digital promotion, with information that can be tracked, recorded, or adjusted for different fields of the coupon where the different fields of the coupon can be adapted/adjusted before or after being given to the user according to user purchasing history, selection of coupons, utilization of coupons, redemption of coupons.

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Furthermore, the information tracked concerning a user and/or coupons includes extensive information related to purchasing and/or coupon utilization.

And, as a further note, Barnett does disclose comparing different stores, comparing different items from different stores, comparing coupons available to items available at different stores (col 10, lines 15-46; Fig. 2, item 30e) and assessing and comparing the prices of items in order to adjust pricing relative to users (col 13, lines 24-35).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Arthur Duran
Patent Examiner
12/15/2005